

## **REMARKS**

This is intended as a full and complete response to the Office Action dated January 15, 2008, having a shortened statutory period for response set to expire on April 15, 2008. Please reconsider the claims pending in the application for reasons discussed below.

Claims 5 and 15 are pending in the application. Claim 5 remains pending following entry of this response. Claim 5 has been amended. Claim 15 has been cancelled. Applicants submit that the amendments do not introduce new matter.

### Interview Summary

On April 10, 2008, a telephonic interview was held between Jon Stewart, attorney for Applicant and Examiner Vu. The parties discussed the cited references including *Bonomi et al* and *Pallakoff*. Claim 5 was discussed. The parties also discussed proposed amendments to claim 5. The proposed amendments are reflected in this response. During the interview, Applicants suggested that *Bonomi et al* in view of *Pallakoff* did not teach the limitations of claim 5, as amended. An agreement was reached during the interview that the proposed amendments should overcome the present rejection based on *Bonomi* and *Pallakoff*.

### Claim Objections

Claims 5 and 15 are objected to because of the following informalities: the terms "wherein the threshold number ... " in last two lines of claim 5 seem referring to "threshold number of subscribers belonging to the subscriber group" that is previously defined in line 10. Applicants have amended claim 5 to address this informality.

Accordingly, Applicants request that the objection be withdrawn. Claim 15 is cancelled with this response.

Claim Rejections - 35 U.S.C. § 112

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 15 has been canceled. Accordingly, Applicants request that the objection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Bonomi et al.* (U.S. Patent No. 6,769,127, hereinafter, “*Bonomi*”) in view of *Pallakoff* (U.S. Patent No. 6,269,343).

The Examiner takes the position that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of *Bonomi* by determining a price based upon a threshold number of purchasers and/or number of purchasers of buying group and enticing people to join in the buying group or offering a discount price as taught by *Pallakoff* in order to provide an effective way of conducting a marketing transaction.”

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criteria.

The cited references, alone or in combination, do not teach all of the claimed limitations as recited by amended claim 5. The Examiner suggests that *Bonomi* teaches the claimed limitation of “a subscriber group defined by two or more subscribers” through the customer list shown in Figure 12A. While Figure 12A does show “a customer list,” this simple fact does not disclose teach the claimed limitation specifying “that the “programming provider maintains a plurality of subscriber groups, wherein each group includes a subset of subscribers.” The customer list is defined as a list “which includes those customers of the media system.” (*Bonomi*, col. 29, lines 46-48). That is, the customer list is what it is, an undifferentiated list of customers of the media system. Clearly, however, *Bonomi* the generic disclosure of a “customer list” does not teach the claimed limitation of “a plurality of subscriber groups, wherein each group includes a subset of subscribers.”

Further, neither *Bonomi* nor *Pallakoff* teach the limitation that “members of each subscriber group are determined prior to an offer to purchase the program,” as recited by amended claim 5. Specifically, *Bonomi* makes no mention of populating a “subscriber group” prior to offering a “subset of subscribers” an offer to purchase a program at a predetermined price, in the manner claimed. Furthermore, as neither *Bonomi* nor *Pallakoff* discloses the claimed “plurality of subscriber groups” having “members ... determined prior to an offer to purchase the program,” it directly follows that neither *Bonomi* nor *Pallakoff* teach the claimed limitation of “offering, to a first subscriber group of the plurality of subscriber groups, the program to purchase at a determined price.”

Additionally, the amended limitations are present in the application’s specification. The specification speaks specifically to “a plurality of subscriber groups” when it states “the plurality of subscribers make up a *plurality of subscriber groups* each including at least two subscribers.” (page 3, lines 25-27). The concept that “the subscribing members of each group are determined prior to the offer of a program to

purchase” is also considered when the specification states “Intent to view information represent that the subscriber has indicated an intent to view a particular program(s). This information can then be transmitted to other subscribers belonging to the same group.” (page 8, lines 11-13). In order for the transmission “to other subscribers belonging to the same group” to occur, the subscriber groups must be “determined prior to the offer.” The added limitation is detailed in the specification when the application states “the message is broadcast to each subscriber belonging to the group.” (page 12, lines 26-27). In other words, this contemplates sending a message that is “offering a program to purchase based on membership in a particular subscriber group.” Members could not logically “belong” to a group that did not exist prior to the offer.

Accordingly, for all the foregoing reasons, Applicants submit that *Bonomi* in view of *Pallakoff*, alone or in combination, do not teach every element recited by Claim 5. Therefore, claim 5 is believed to be allowable and allowance is respectfully requested.

### Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

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